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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/772,117      | 02/05/2004  | Carly Uretzky-Miller | 5470                | 4295             |

7590 10/07/2004

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| EXAMINER |
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MAYO, TARA L

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| ART UNIT | PAPER NUMBER |
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3671

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/772,117 | <b>Applicant(s)</b><br>URETZKY-MILLER, CARLY |  |
|                              | <b>Examiner</b><br>Tara L. Mayo      | <b>Art Unit</b><br>3671                      |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: typographical error. On page 14 at line 13, delete "2C" and insert therefor --1C--. Appropriate correction is required.

### *Claim Objections*

2. Claim 15 is objected to because of the following informalities: improper dependence upon itself. Change the dependency of claim 15. Appropriate correction is required. Claims 15 and 16 have not been further prosecuted on the merits.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 through 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the scope of the claimed invention rendered indefinite by Applicant's recitation of "said mat" on lines 4 through 5. Specifically, it is unclear whether the claim is intended to be drawn to the bag or to the combination of the bag and the mat. For

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the purposes of prosecution, the Examiner has considered the claim to be drawn to the bag alone.

Claim 6 is rejected as being an improper Markush-type claim. On line 2, amend the claim to read --...selected from the group consisting of cottons...--.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nathan (U.S. Patent No. 4,156,446).

Nathan '446, as seen in Figures 1 through 4, shows a carry bag (11) of substantially cylindrical configuration having an open first end and a closed opposite second end (25), the bag being capable of holding a rolled yoga mat inserted through said first end, with said closed second end being yet air permeable to ventilate a mat when placed within.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan (U.S. Patent No. 4,156,446).

Nathan '446 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claim 2,

the bag comprising a non-synthetic material.

With regard to claim 2, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Nathan '446 such that it would comprise a non-synthetic material (e.g., a plastic coated cotton fabric). The motivation would have been to produce a desired aesthetic effect.

9. Claims 3 through 14 and 17 through 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan (U.S. Patent No. 4,156,446) in view Benedict (U.S. Patent No. 5,956,759).

Nathan '446 further discloses:

with regard to claims 7 and 17,

a drawstring at said first end for closing said carry bag.;

with regard to claims 8 and 18,

a shoulder strap (32,33) on an outside surface of said carry bag extending between top and bottom portions thereof.

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Nathan '446 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claims 3, 4 and 9,

the second end of the bag comprising a crocheted end cap;

with regard to claim 4,

the bag comprising a non-synthetic material;

with regard to claims 5, 9 and 19,

the bag comprising a non-synthetic fabric;

with regard to claim 6,

the non-synthetic fabric being selected from the group consisting of cottons, velvets, velours, silks, brocades and tapestries;

with regard to claim 10,

the non-synthetic fabric being composed of one of a rich color and pattern display;

with regard to claim 11,

the non-synthetic fabric being of a floral, batik and nature scene display;

with regard to claim 12,

the non-synthetic fabric being of a cotton composition;

with regard to claim 13,

the bag being of substantially 9" x 29" and 11" x 33" diameter and length dimensions, respectively;

with regard to claim 14,

a rolled yoga mat.

Benedict '759, as seen in Figures 1 through 3, shows a hat (10) comprising mesh portions (20, 25, 30) formed by crochet to facilitate airflow and evaporation (col. 3, lines 11 through 15).

With regard to claims 3, 4 and 9, it would have been obvious to one having ordinary skill in the art of bags at the time the invention was made to modify the device shown by Nathan '446 such that the end cap (25) would comprise a crocheted material as taught by Benedict '759. The motivation would have been to promote airflow and evaporation.

With regard to claims 4 through 6, 9, 12 and 19, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Nathan '446 such that it would comprise cotton fabric. The motivation would have been to produce a desired aesthetic effect.

With regard to claims 10 and 11, the recitations of ornamental display have not been given patentable weight since it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

With regard to claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the bag shown by Nathan '446 of desired

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dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regard to claim 14, it would have been obvious to one having ordinary skill in the art of bags at the time the invention was made to modify the device shown by Nathan '446 such that it would be in combination with a yoga mat. The motivation would have been facilitate storage and transport of a yoga as desired.

#### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

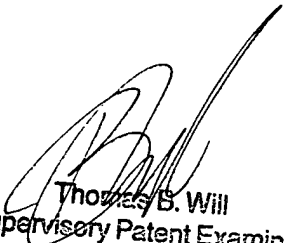


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'tim'.

01 October 2004

A handwritten signature in black ink, appearing to be 'Thomas B. Will'.

Thomas B. Will  
Supervisory Patent Examiner  
Group 3600